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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,663	10/02/2000	William E. LeBoeuf	J-2961	3408
28165	7590	08/11/2004	EXAMINER	
S.C. JOHNSON & SON, INC. 1525 HOWE STREET RACINE, WI 53403-2236			CHEVALIER, ALICIA ANN	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/677,663	LEBOEUF ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alicia Chevalier	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5,7-15,17-25,27,28,30,32-39,42-81,83-89 and 91-95 is/are pending in the application.
- 4a) Of the above claim(s) 51-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7-15,17-25,27,28,30,32-39,42-50,80,81,83-89 and 91-95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>Nov. 10, 2003</u> | 6) <input type="checkbox"/> Other: _____  |

**RESPONSE TO AMENDMENT**

***Request for Continued Examination***

1. The Request for Continued Examination (RCE) under 37 CFR 1.53 (d) filed on May 3, 2004 is acceptable and a RCE has been established. An action on the RCE follows.
2. Claims 1, 2, 5, 7-15, 17-25, 27, 28, 30, 32-39, 42-81, 83-89 and 91-95 are pending in the application, claims 51-79 are withdrawn from consideration. Claims 3, 4, 6, 16, 26, 29, 31, 40, 41, 82 and 90 have been cancelled.
3. Amendments to the specification and the claims, filed on May 24, 2004, have been entered in the above-identified application.

***Drawings***

4. Replacement drawings were received on May 24, 2004. These drawings are acceptable.

**WITHDRAWN REJECTIONS**

5. The objections to claim 31, made of record in paper #28, mailed October 27, 2003, page 3, paragraph #11 has been withdrawn since Applicant had cancelled claim 31 in the response filed May 24, 2004.
6. The 35 U.S.C. §112, second paragraph, rejections of claims 39 and 88, made of record in paper #28, page 5, paragraph #14 have been withdrawn due to Applicant's amendment in the response filed May 24, 2004.

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7. The 35 U.S.C. §102 rejection of claims 1, 2, 5, 7-10, 14, 15, 17-21, 25, 27, 28, 30-35, 39, 42-47, 80, 81, 83-89 and 91-95 over Endres (US Patent No. 3,441,021), made of record in paper #28, pages 5-9, paragraph #15 has been withdrawn due to Applicant's amendment in the response filed May 24, 2004.

8. The 35 U.S.C. §102 rejection of claims 1, 2, 5, 7-9, 11-15, 17, 18-20, 22-25, 27, 28, 30-34, 36-39, 42-46, 48-46, 80, 81, 83-86, 88, 89 and 91-94 over Morris (US Patent No. 4,755,413), made of record in paper #28, pages 9-13, paragraph #16 has been withdrawn due to Applicant's amendment in the response filed May 24, 2004.

#### ***REJECTIONS REPEATED***

9. The 35 U.S.C. §112, first paragraph, rejection of claims 1, 2, 5, 7-15, 17-25, 27, 28, 30, 32-39, 42-50, 80, 81, 83-89 and 91-95 is repeated for reasons previously made of record in paper #28, page 4, paragraph #13.

Claims 1, 2, 5, 7-15, 17-25, 27, 28, 30, 32-39, 42-50, 80, 81, 83-89 and 91-95 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitations "wherein substantially no portion of the film layer adjacent the holes extends into the liquid absorbent portion" (claim 1), "wherein substantially no portion of the top surface adjacent the holes of the thermoplastic film extends into the liquid absorbent portion" (claim 14), "wherein substantially no portion of the material adjacent the holes of the first

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material extends into the second material” (claim 25), “wherein substantially no portion of the first means adjacent the holes of the thermoplastic material extends in to the second means” (claim 39), “wherein substantially no portion of the material adjacent the holes of the thermoplastic material extends into the second material” (claim 80), and “wherein substantially no portion of the material adjacent the holes of the continuous film extends into the second material” (claim 88) were add to the independent claims and is considered new matter.

The specification merely recites that a continuous sheet of polymer film could be used as the upper layer, wherein the film is perforated (*specification page 9, line 28 through page 10, line 10*). The specification does not have support for excluding the portion of the film adjacent the holes from extending into the liquid absorbent portion. Furthermore, there is no discussion or disclosure in the specification about the portions of the film adjacent the holes. Therefore, the limitations added to the independent claims, listed above, are considered new matter and should be removed.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. MPEP 2173.05(i).

***NEW REJECTIONS***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112***

11. Claims 1, 2, 5 and 7-13 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Newly amended claim 1 now recites, “wherein the thermoplastic film layer is of a thickness within the range of about 2 to about 5 mils” and is considered new matter.

The specification only has support for the thermoplastic film layer having a thickness of approximately 5 mils (*specification page 10, lines 11-15 and the examples on page 13*). There is no discussion or disclosure in the specification about the thermoplastic film layer having a thickness of 2 mils or any specified range. Therefore, the above limitation is considered new matter and should be removed.

***Claim Rejections - 35 USC § 102***

12. Claims 1, 2, 5, 7-9 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Morris (U.S. Patent No. 4,755,413).

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Regarding Applicant's claim 1, Morris discloses a single use processing substrate (*disposable absorbent article, col. 1, lines 10-11*) comprising a continuous thermoplastic film layer (*top sheet/facing material made of a thermoplastic such as polyethylene film, col. 5, lines 28-29 and col. 3, lines 36-38*), a liquid impervious barrier disposed opposite the film layer (*liquid impermeable backsheet, col. 5, lines 27-29 and figure 5*), and a liquid absorbent portion disposed adjacent the film layer (*absorbent core, col. 5, lines 27-29 and figure 5*).

The continuous thermoplastic film layer is liquid permeable (*col. 5, lines 28-29*) having holes (*apertures, col. 3, line 37*) disposed therein. The thermoplastic film has a thickness within the range of about 2 mils to about 5 mils, since the reference discloses that the film should have a thickness in the range of 0.5 to 1.5 mils (*col. 3, lines 30-31*). 1.5 mils is deemed to be **about 2** mils. Reference figure 5 shows that substantially no portion of the film layer adjacent the holes extends into the liquid absorbent portion.

Regarding Applicant's claim 2, Morris discloses that the liquid absorbent portion is disposed between the film layer and the liquid impervious barrier (*col. 5, lines 27-29 and figure 5*).

Regarding Applicant's claim 5, Morris discloses that the thermoplastic of the film layer is selected from the group consisting of polyolefins, polyesters, polystyrene, polyvinyl alcohol, polyvinyl chloride, nylon, polyacrylonitrile, acrylonitrile-butadiene-styrene copolymer (ABS) and ethylvinylacetate, since the reference teaches that the film used to make the top sheet may be a polyolefin, a vinyl or an acrylic film (*col. 3, lines 22-25*).

Regarding Applicant's claims 7 and 8, the limitations "wherein the holes in the film layer are formed by punching" (claim 7) and "wherein the holes in the film layer are formed by

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perforating” (claim 8) are a method limitations and do not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Also, the specification does not appear to give any importance to the process to make the holes in the film since it discloses “the film is perforated by any suitable process” (specification page 9, lines 33-34). Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Morris discloses a continuous thermoplastic film layer having holes (*apertured facing material, col. 3, lines 14-15*).

Regarding Applicant’s claim 9, Morris discloses that the liquid absorbent portion comprises cellulosic material, since the reference teaches that the absorbent core comprises cellulosic fibers (*col. 5, line 41*).

Regarding Applicant’s claims 11-13, Morris discloses that the liquid impervious barrier is formed by a layer of thermoplastic resin that comprises a continuous sheet of material (*backsheet of thermoplastic material such as polyethylene, col. 5, lines 58-60 and figure 5*). Morris further discloses that the thermoplastic of the film layer is selected from the group consisting of polyolefins, polyesters, polystyrene, polyvinyl alcohol, polyvinyl chloride, nylon, polyacrylonitrile, acrylonitrile-butadiene-styrene copolymer (ABS) and ethylvinylacetate, since the reference teaches that the backsheet is formed of polyolefins such as polyethylene or polypropylene (*col. 5, lines 58-60*).



***ANSWERS TO APPLICANT'S ARGUMENTS***

13. Applicant's arguments in the response filed May 24, 2004 regarding the 35 U.S.C. 112, first paragraph rejection regarding the portions adjacent the holes in the film of record have been carefully considered but are deemed unpersuasive.

Applicant argues that the proposed amended figure 3 in the instant application shows the various layers are discrete and do not have any portions that extend into the adjacent layer. First, when the specification does not disclose that the drawings are to scale, therefore the drawings are considered to be exemplary only, i.e. they are one possible embodiment. There is no discussion in the specification with regard to figure 3 about the portions adjacent the holes. Therefore the limitations regarding the adjacent portions of the holes in the film are considered new matter. Furthermore, drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or (ii) to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim. MPEP 608.02

Applicant further argues that the specification elaborates on numerous securing and forming methods for the various layers and that it is apparent from the these methods that such methods could not result in portions of film adjacent the holes extending into the absorbent portion. The Examiner respectfully disagrees with Applicant that the methods of securing and forming the various layers could **not** result in the portions adjacent the holes extending into the absorbent portion. However, as pointed out above, the specification does not discuss the portions of the film adjacent the holes. More specifically the specification does not have support

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for excluding the portions of the film adjacent the holes from extending into the liquid absorbent portion.

14. Applicant's arguments in the response filed May 24, 2004 regarding the 35 U.S.C. 112, second paragraph rejections of record have been considered but are moot since the rejections have been withdrawn.

15. Applicant's arguments in the response filed May 24, 2004 regarding the 35 U.S.C. 102 rejections over Endres and Morris of record have been considered but are moot since the rejections have been withdrawn and a new grounds of rejection has been given with the Morris reference.

#### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Chevalier

8/9/04

